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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,605	01/25/2001	Glenn Ricart	300/2	4396
27538	7590	02/23/2004	EXAMINER	
KAPLAN & GILMAN, L.L.P. 900 ROUTE 9 NORTH WOODBIDGE, NJ 07095			HANNE, SARA M	
			ART UNIT	PAPER NUMBER
			2173	8

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b>		<b>Applicant(s)</b>	
	09/769,605		RICART ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sara M Hanne		2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:  
    1. ☐ Certified copies of the priority documents have been received.  
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**BA HUYNH**  
**PRIMARY EXAMINER**

### **DETAILED ACTION**

1. This action is responsive to the amendment received on November 3, 2003.

Amended Claims 1-22 are pending in the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by East et al., U.S. Patent Publication No. 2003/0061323.

In accordance with Claim 1, East et al. discloses sending a generic server personalization information for personalizing the server and sending the server personalization information for personalizing a client of the server ("remote/master administrative server 202B controls updates for thin clients 200C-D and remote administrative server", Pg. 4, Par. 50).

Claim 2 teaches that the information sent must be at least one of "the server's name, the domain in which it resides . . ." etc. taught by East et al. by configuring the network ("changing TCP/IP configurations", Pg. 5, Par. 54).

Claim 3 also teaches that the information sent can be Windows operating system registry information. East et al. teaches this limitation by installing a new device ("an operating system update, the addition of a new device driver, a change in device settings", Pg. 4, Par. 50). Also, the background art in this patent application does refer to prior art listed on novell.com in the form of software that can collect the Desktop policies and profiles, which would include registry information and corporate policy information.

As in Claim 7, East et al. further discloses the server to receive the personalization information for the Server and for the Client, the server personalizing itself according to this information, sending the Client it's information, and the Client personalizing itself based on the information it receives ("Remote/master administrative server 202B then conveys the update to remote server 202C and thin clients 200C-D. Remote server 202C then conveys the update to thin clients 202E-N.", Pg. 5, Par. 50).

As in Claim 4, East et al. teaches personalizing the server after the client has been personalized as seen in the rejection of Claim 7 *supra*. Therefore the system ignores workstation requests for personalization until the server is personalized.

As in Claim 8, East et al. teaches the client to be a laptop disconnectable from the server ("LAN 104 may include a number of interconnected computer systems and optionally one or more other devices: for example, one or more workstations 110a, one

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or more personal computers 112a, one or more laptop or notebook computer systems 114, one or more server computer systems 116, and one or more network printers 118.", Pg. 3, Par. 36).

As in Claim 9, East et al. teaches a higher-tier server that receives personalization information for the client's server and provides this information back to the server after the server receives it and at least partially personalizes itself using this information ("an administrative server is a computer that controls updates and configurations for one or more other administrative servers and/or one or more thin clients", Pg. 4, Par. 50).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over East et al., U.S. Patent Publication No. 2003/0061323.

As in Claim 5, East et al. teaches personalizing the client as seen in the rejection of Claim 7 *supra*. East et al. fails to teach ignoring user requests until the client is at least partially personalized as recited in the claims. It would be obvious to one of ordinary skill in the art to ignore user requests temporarily until the client has been personalized at least partially. One would have been motivated to make such a

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combination because a personalization method that is executed long enough so that it may complete the request of the user would have been obtained.

As in Claims 10 and 11, East et al. teaches transmission of Roles and Workstation information as further described in Claim 7 of the application seen *supra*. East et al. fails to teach one piece of information to be dominate or submissive to another. It would be obvious to one of ordinary skill in the art to make a specific piece of information, roles workstation or user information, dominate or submissive. One would have been motivated to make such a combination because a personalization method for controlling the order in which the information is processed would have been obtained.

As in Claim 12, East et al. teaches collecting and storing server and client personalization information pertaining to the existing server and client, sending the personalization information to a new server (Copy Configuration, Pg. 5, Par. 56-58) to personalize the server with the other server's information, and sending the personalization information for the Client to a new client to personalize the client with the other client's information ("plug-and-play customization for new clients.", Pg. 6, Par. 60). East et al. fails to teach the new client/server to be replacements for the old client/server. It would be obvious to one of ordinary skill in the art to remove the old client/server and replace them with the new ones that have a copy of the old client/server's personalization information. One would have been motivated to make such a combination because a personalization method that can remove old hardware would have been obtained.

Further in reference to Claim 13, East et al. teaches the personalization information to be stored with a remote service provider (Remote/master administrative server 202B).

In reference to Claim 14, East et al. teaches the personalization information to include roles information (Figure 8 clusters, and MAC address), net information ("network management information can be transferred", Pg. 8, Par. 90), client information (Claim 7 rejection *supra*) and user information ("change in device settings", Pg. 4, Par. 50).

In reference to Claim 15, East et al. teaches the role information comprising personalization information common to or driven by roles or functions within a company. They further teach the net information comprising personalization information common to a workgroup, network, or server, along with client information comprising personalization information specific to the client and user information comprising information specific to a user (see Claim 14 rejection, *supra*).

### ***Response to Amendment***

6. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new rejection as applied above. With respect to the argument that the reference has failed to teach the limitation that both server and client personalization information is sent to the server, the newly applied reference clearly discloses this limitation as seen *supra*.

***Conclusion***

7. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach further examples of personalization information exchange between clients and servers and hardware replacement with remote computer systems.



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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (703) 308-0703. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

smh

BA HUYNH  
PRIMARY/EXAMINER